

*filed  
Aug. 10, 1979*

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IN THE  
Supreme Court of the United States  
OCTOBER TERM, 1979

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No. ... **79-223**

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REID C. GOODBAR and ARTHUR M. PRESSLEY,  
Junior Party Patentees,  
*Petitioners,*  
*vs.*

DONALD W. BANNER, Commissioner of Patents  
and Trademarks,  
MARVIN A. CHAMPION, NORMAN G. TORCHIN, and  
MICHAEL SOFOCLEOUS, Members U.S. Patent and  
Trademark Office Board of Patent Interference,  
*and*  
WILLIAM KLEIN, Senior Party Applicant,  
*Respondents.*

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PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF CUSTOMS  
AND PATENT APPEALS

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JOSEPH J. C. RANALLI  
330 Madison Avenue  
New York, New York 10017  
*Counsel for all Petitioners*

*Of Counsel*

JOSEPH J. CATANZARO  
FREDERICK F. CALVETTI

PENNIE & EDMONDS  
330 Madison Avenue  
New York, New York 10017  
*Attorneys for all Petitioners*

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PETITION FOR A WRIT OF CERTIORARI TO THE  
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AND PATENT APPEALS

Petitioners respectfully pray that a Writ Of Certiorari  
issue to review the order of the United States Court of Customs  
and Patent Appeals entered in this proceeding on May  
31, 1979.

### Decision Below

The decision of the United States Court of Customs and Patent Appeals was reported as *Goodbar v. Banner*, — F.2d —, 202 USPQ 106 (CCPA 1979) and appears in the Appendix.

### Jurisdiction

The decision of the United States Court of Customs and Patent Appeals was rendered on May 31, 1979. This Petition For Writ Of Certiorari was filed within 90 days of that date. This Court's jurisdiction is invoked under 28 USC 1256. *Brenner v. Manson*, 383 U.S. 519 (1966).

### Question Presented

Whether the United States Court of Customs and Patent Appeals (CCPA) erred in holding that it is without jurisdiction to entertain a Petition For Writ Of Mandamus to vacate a discovery order issued by the U.S. Patent and Trademark Office Board of Patent Interferences (board) because the discovery order might not result in evidence related to the issue of priority or to an ancillary issue involving priority?

### Statement of the Case

The Petition For Writ Of Mandamus derived from United States Patent Interference No. 98,935. On March 6, 1975, the U.S. Patent and Trademark Office (PTO) declared an interference between Reid C. Goodbar and Arthur M. Pressley (Goodbar), junior party patentees,<sup>1</sup> and William

<sup>1</sup> U. S. patent No. 3,703,073 issued to Goodbar on November 21, 1972 based on application serial No. 63,755, filed August 14, 1970.

G. Klein (Klein), senior party applicant.<sup>2</sup>

The junior party in an interference is the first to present evidence on the issue of priority, i.e., evidence that the junior party was the first to conceive the invention and the first to reduce it to practice. Goodbar presented evidence of his conception and reduction to practice during his testimony-in-chief and the senior party, Klein, during cross-examination, made certain discovery requests under 37 CFR 1.287(b). That section provides:

(b) The provisions of paragraph (a) of this section are without prejudice to the right of a party, *where appropriate*, to obtain production of documents or things during cross-examination of an opponent's witness or during his own period for rebuttal testimony. [Emphasis added.]

Goodbar refused Klein's requests on the grounds that those requests were inappropriate. On July 18, 1978, Klein filed a Motion For Production of Documents under 37 CFR 1.287(c). That section provides:

(c) Upon motion (§ 1.246)<sup>3</sup> brought by a party during the period for preparation for testimony, or thereafter as authorized under § 1.246, and upon a *showing that the interest of justice* so requires, the Board of Patent Interferences may order additional discovery as to matters under the control of a party within the scope of the discovery rules of the Federal Rules of

<sup>2</sup> U. S. application serial No. 262,108 was filed by William G. Klein on June 12, 1972 and is a division of application serial No. 29,822 filed April 4, 1970, which matured into U. S. patent No. 3,678,675.

<sup>3</sup> 37 CFR 1.246 provides:

A motion or other paper belatedly filed will not normally be considered except upon a showing, under oath or in the form of a declaration (§ 1.68), of sufficient cause as to why such motion or paper was not timely presented.



Civil Procedure, specifying the terms and conditions of such additional discovery. An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority. [Emphasis added.]

Klein's motion contained twenty-two (22) requests for production of documents. The board denied all but three (3) of Klein's requests. Because Goodbar responded to one request and is prepared to respond to another, only one request was in issue. Goodbar petitioned to the Commissioner of Patents and Trademarks (Commissioner) to reverse the decision of the board granting discovery on the remaining request.

Goodbar maintained that the board abused its discretion. Goodbar's principle objection was that the board had improperly provided discovery of documents which are privileged and/or proprietary without just cause or proper safeguards.

After offering an interpretation of the board's decision, the Commissioner affirmed the board's order. However, that interpretation did not obviate Goodbar's principal objection to the board's decision. Consequently, Goodbar petitioned the CCPA for issuance of a Writ Of Mandamus pursuant to 28 USC 1651(a) of the All Writs Act, 28 USC 1542(1), 35 USC 141 and CCPA Rule 7.1.

Goodbar urged that the CCPA had jurisdiction to entertain his petition based on that Court's specific holding in *Cook v. Dann, Comm'r of Pats.*, 522 F.2d 1276, 188 USPQ 175 (CCPA 1975). Although the CCPA denied Cook's Petition For Writ Of Mandamus on the merits of his petition, the CCPA specifically held that it had the authority to issue a Writ of Mandamus to review a decision by the board under 37 CFR 1.287(c) prior to a determination of priority.

On May 31, 1979, Goodbar's petition was, nevertheless, *dismissed* on the ground that the CCPA was without power to entertain the Petition For A Writ Of Mandamus "since the matter complained of is not one which would be cognizable before this court on appeal from a decision of the board awarding priority. [A8]"

The CCPA's *ratio descendendi* centers on the following, — F.2d at —, 202 USPQ at 109:

The language relied upon here by petitioners was not intended to convey the meaning they wish to ascribe to it. In *Cook*, the court stated "The Patent [and] Trademark Office (PTO) respondents' challenge to our jurisdiction under the All Writs Act (28 U.S.C. § 1651(a)) must be rejected." 522 F.2d at 1276, 188 USPQ at 176. We were there responding to a suggestion by the Commissioner in the PTO brief that "As previously submitted in the commissioner's opposition to the petition in *Duffy v. Tegtmeyer* [citation], *the court lacks jurisdiction to issue an order in the nature of mandamus on the commissioner in a patent case.*" (Emphasis ours.)

Thus, while it may not be clear from the face of the court's opinion in *Cook*, we did not there intend to imply that this court had jurisdiction over the action complained of by Cook. We were there dealing with this court's basic power to act under the All Writs Act in attempting to correct the erroneous interpretation of the law by the PTO to the effect that this court could *never* issue a writ of mandamus to the Commissioner in a patent case. As to the merits in *Cook*, we were of the opinion that, assuming subject matter jurisdiction to be present, we could not find an abuse of discretion on the part of the PTO. In *Cook* we did not decide whether we had jurisdiction. [A6-A7] [Insertions and emphasis in original.]

### Reasons for Granting the Writ

The CCPA candidly admitted that the "recent proliferation of petitions for extraordinary relief" is the reason for it to "once more . . . analyze the jurisdictional basis which empowers us to grant such relief [A7]."

Goodbar submits that the CCPA should not be permitted *sua sponte* to limit its jurisdiction as a means of alleviating its case load particularly where the self-imposed limitation prevents it from fulfilling its duties as an appellate court.

Goodbar asserted that the board had improperly provided discovery of documents which contain privileged and/or proprietary information. This is the very type of situation where appellate courts have not hesitated to invoke their jurisdiction by way of mandamus because it is well recognized that once the information is improperly exposed the privileged and proprietary nature of that information is lost forever. This Court's review, therefore, is necessary to safeguard these important rights and privileges.

A further reason for the Court to grant the writ is that a conflict presently exists between the CCPA and the Second Circuit Court of Appeals regarding the extent of the CCPA's jurisdiction in discovery matters under 37 CFR 1.287(c). Guidance from this Court is necessary if uniformity among the courts is to be obtained.

### I

#### In Denying Jurisdiction, The CCPA Committed Error Which Will Seriously Erode Long Standing Legal Principles.

Courts have issued writs of mandamus under circumstances similar to those involved here to prevent dissemination of privileged and confidential information.

*Diversified Industries, Inc. v. Meredith*, 572 F.2d 596 (8th Cir. 1977); *U.S. Board of Parole v. Merhige*, 487 F.2d 25 (4th Cir. 1973), *cert. denied*, 417 U.S. 918 (1974); *Harper & Row Publishers, Inc. v. Decker*, 423 F.2d 487 (7th Cir. 1970), *aff'd* 400 U.S. 348 (1970); *U.S. v. Hemphill*, 369 F.2d 539 (4th Cir. 1966).

The CCPA in *Cochran v. Kresock*, 530 F.2d 385, 396, 188 USPQ 553, 561 (CCPA 1976) recognized the principle that proprietary information should be guarded and also set forth the standard for review under 37 CFR 1.287(c) involving such information:

Paragraph (c) of Rule 287 states that the additional discovery provided by the paragraph *may* be granted by the board. It is therefore clear that the discovery sought by appellant is not a matter of right, but rather is discretionary with the board. We do not ordinarily interfere in matters which are discretionary within the Patent and Trademark Office *unless there has been a clear showing of abuse of that discretion*. *Cook v. Dann, Comm'r of Pats.*, 522 F.2d 1276, 188 USPQ 175 (CCPA 1975). [Emphasis in original.]

Thus, the CCPA recognized the importance of safeguarding this type of information from improper dissemination. Nevertheless, it now states that it is without jurisdiction to entertain a writ of mandamus seeking to do just that.

The CCPA's statements in *Cochran*, its reliance therein on *Cook* and the fact that the petition in *Cook* was denied rather than dismissed<sup>4</sup> demonstrate that the CCPA's failure

<sup>4</sup>The CCPA explained the significance between the terms "denied" and "dismissed", — F.2d at —, 202 USPQ at 109:

Even in cases where the writ does not issue, there is a significant difference between dismissing a petition for lack of jurisdiction and denying a petition for want of a good case on the merits. [A7].



to find jurisdiction is little more than a method to reduce "the recent proliferation of petitions." This Court should therefore grant this petition and issue a Writ of Certiorari so that the significant issues raised in the Petition For Writ Of Mandamus may be given a proper review.

## II

### **There Is A Clear And Substantial Conflict Between The Second Circuit And The CCPA Regarding PTO Discovery Rule 37 CFR 1.287(c).**

The CCPA based its decision on the fact that review of the board's order would not be ancillary to priority and consequently would not be subject to review on appeal to the CCPA from a final decision of the board awarding priority of invention. The CCPA does, however, have the power to review the board's discovery decision on appeal. 37 CFR 1.287(c) specifically provides for such a review. The rule states, in pertinent part:

An order by the Board *granting or denying* a motion under this paragraph shall not be subject to review *prior to a decision awarding priority*. [Emphasis added.]

The Second Circuit recently reviewed this rule in *Shattuck v. Hoegl*, 555 F.2d 1118, 194 USPQ 405 (2nd Cir. 1977). The matter there under review was a decision of the District Court for the Northern District of New York in connection with an ancillary PTO interference discovery proceeding instituted under 35 USC 24. Judge Meskill writing for the Court stated, 555 F.2d at 1121, 194 USPQ at 408:

A party in the position of IBM is not left without a remedy. The Patent Office has recently adopted a rule [37 CFR 1.287] under which discovery may be conducted in interference proceedings. Moreover, a party

disappointed by an interference proceeding has access to two Article III courts. *An appeal may be taken to the Court of Customs and Patent Appeals*. If that court finds that discovery against a party should have been ordered, it can vacate the decision of the Patent Office . . . Inasmuch as the chosen forum for review may be able to remedy any error in the discovery proceedings there is no reason to allow this interlocutory appeal. [Footnotes omitted; emphasis added.]

Even though *Shattuck* involved an interlocutory appeal, that fact does not distinguish that authority here. Simply, the Second Circuit has recognized that matters involving discovery before the board are reviewable by the CCPA and that the CCPA can remedy errors in such proceedings. The CCPA, in holding that it lacks jurisdiction to review discovery matters either by way of mandamus or appeal, disregards the Second Circuit's holding in *Shattuck*.

As a consequence of the decision below, petitioners are obliged to turn over what may well be critical, privileged documents as well as substantial proprietary information to a competitor without review of any court even after priority has been determined. What is more anomalous is that the CCPA is able to conclude that the subject matter sought to be discovered does not involve a question of priority and is not ancillary to priority while prefacing this conclusion by saying that "it is not known whether the requested discovery will actually lead to *legally relevant* and *admissible* evidence. [Emphasis in original.]" (A7).

Goodbar submits this Court should grant this petition to resolve this anomalous situation so that uniformity among courts will exist regarding discovery proceedings under 37 CFR 1.287(c).

**CONCLUSION**

For the reasons presented, this Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

JOSEPH J. C. RANALLI  
*Counsel for all Petitioners*

*Of Counsel*

JOSEPH J. CATANZARO  
FREDERICK F. CALVETTI  
PENNIE & EDMONDS  
330 Madison Avenue  
New York, New York 10017  
*Attorneys for all Petitioners*

**APPENDIX****Decision of the Court of Customs and Patent Appeals.****UNITED STATES COURT OF CUSTOMS AND  
PATENT APPEALS**

Appeal No. 79-555.

On Petition for Writ of Mandamus

Interference No. 98,935.

REID C. GOODBAR and ARTHUR M. PRESLEY,  
Junior Party Patentees,  
Petitioners,

v.

DONALD W. BANNER, Commissioner of  
Patents and Trademarks,

MARVIN A. CHAMPION, NORMAN G. TORCHIN, and MICHAEL  
SOFOCLEOUS, Members U. S. Patent and Trademark Office  
Board of Patent Interference, and

WILLIAM KLEIN, Senior Party Applicant,

Respondents.

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DECIDED: May 31, 1979

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Before MARKEY, Chief Judge, RICH, BALDWIN, LANE,\* and  
MILLER, Associate Judges.

RICH, Judge.

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\* Judge Lane took part in the consideration and decision of this matter but died before the decision was announced.



*Appendix—Decision of the Court of Customs  
and Patent Appeals.*

Petitioners seek a writ of mandamus, directing the Patent and Trademark Office (PTO) Board of Patent Interferences (board) to vacate its order compelling petitioners to produce for inspection and copying certain documents in connection with interference No. 98,935. Respondents are the Commissioner of Patents and Trademarks (Commissioner), the board, and Klein, petitioners' interference adversary. Oppositions to the petition have been filed by the Commissioner and Klein.

This petition was kindled by testimony elicited from Dr. Roger Varin, former Director of Research for Riegel Textile Corporation, assignee of the junior party petitioners' patent. This testimony was taken during the junior party petitioners' testimony-in-chief period. Specifically, on cross-examination, Dr. Varin testified that he kept a file of correspondence generated while he was employed by Riegel. After testifying that he was familiar with the contents of the file, the following was elicited:

Q. Did you find anything relating to this proceeding?

A. There were some things.

As a result of this testimony, respondent Klein filed a MOTION FOR PRODUCTION OF DOCUMENTS UNDER 37 CFR 1.287 (b) and (c) requesting, inter alia, the production of Dr. Varin's correspondence file for inspection and copying.

Petitioners opposed production of the file. They asserted that the request was overly broad and indefinite and would require the production of documents containing confidential and proprietary information. They also stated that Klein has failed to show that production of the file would be in the "interests of justice" as required by 37 CFR 1.287(c).

The board granted respondent Klein's motion, but only to the extent that the documents to be produced were the

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and Patent Appeals.*

ones referred to in Dr. Varin's testimony as being related to this proceeding. The board stated:

With regard to requests 2, 4 and 5 [request 5 is the only one at issue here], the motion is granted as being in the "interest of justice". As to request 2, there is no ostensible objection. As to requests 4 and 5, the motion paper indicates that Klein ascertained the probable existence of the photographs [the subject of request 4] and the "somethings" [sic, some things] during cross-examination and their existence could not have been determined earlier by inspecting the documents served under § 1.287(a). *Also request 5 is considered properly limited to the subject matter of the counts in issue inasmuch as it is limited to "some things" [sic, some things] related to this proceeding.* [Emphasis ours.]

The board adhered to this decision on reconsideration.

Relief was requested from the Commissioner by a petition to reverse the decision of the board. Commissioner Banner denied the petition with the following comments:

Petitioners maintain that the board should have denied request 5 because the documents sought thereby were not limited in scope to a relevant time period. It is apparent that petitioners have misinterpreted the board's order. *A fair reading of the board's order, taken in light of the motion and opposition before the board and Dr. Varin's cross-examination, demonstrates that the board only ordered petitioners to make discovery of the "some things" in his file which relate "to this proceeding," or as respondent's counsel put it those things which "relate to this subject matter."*

*Since the board's order properly limits the documents, both as to scope of time and subject matter, it follows*

*Appendix—Decision of the Court of Customs  
and Patent Appeals.*

that the board correctly ruled on respondent's request 5. [Emphasis ours.] Accordingly, the decision of the board granting request 5 is *affirmed* [emphasis in original].

Petitioners assert an abuse of discretion on the part of the board in granting the request, and on the part of the Commissioner in refusing to reverse the board's decision. They claim, as they did before the board, that the request is overly broad and indefinite, and that the material sought to be discovered is proprietary and confidential. We are asked to issue mandamus to vacate the decision of the board and its order requiring the production of documents as per request 5.

Petitioners have also, by motion, requested oral argument on their PETITION FOR MANDAMUS. Respondent Klein opposes the motion.

OPINION

1. *Request for Oral Argument*

The motion for oral argument is denied. Oral arguments on petitions for extraordinary relief are not granted unless directed by this court. See CCPA Rule 7.1(b). The court does not find oral argument helpful in cases such as this where the issues are clear and the case is not complex. Cf. *United States v. Watson, Judge, United States Customs Court and Michelin Tire Co.*, Appeal No. 79-17, argued May 2, 1979 (oral argument granted on Government's motion due to complexity and importance of issues).

2. *The Requested Writ*

Under 28 USC 1651(a), the All Writs Act, this court, as one "established by Act of Congress," has the power to issue all writs "necessary or appropriate in aid of [our]

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and Patent Appeals.*

jurisdiction" (emphasis ours). *Loshbough v. Allen*, 56 CCPA 913, 404 F.2d 1400, 160 USPQ 204 (1969). The All Writs Act is not an independent grant of appellate jurisdiction, and, therefore, the appellate jurisdiction which the writs are "in aid of" must have some other basis. *Roche v. Evaporated Milk Assoc.*, 319 U.S. 21, 23-26 (1943). This basis, of course, must be found within the *subject matter jurisdiction* of this court, since the All Writs Act does not bestow upon this court the power to adjudicate issues falling outside of this jurisdiction. The crucial question is thus whether we have subject matter jurisdiction over the issues presented in the petition for extraordinary relief. For this reason, it is incumbent upon any petitioner seeking such relief in this court to demonstrate that we have subject matter jurisdiction over the issue involved.

The present petition arises out of an interference. Specifically, it is the result of a decision of the board which granted the senior party's request for additional discovery, made by motion under 37 CFR 1.287(b) and (c). Since there is no appeal from decisions of the board on motions, any support for the jurisdiction of this court must be found elsewhere.<sup>1</sup>

<sup>1</sup> We, like all other federal appellate courts, are bound by the final judgment rule which limits our jurisdiction to final decisions of the PTO appeal boards, as contrasted with decisions which are merely interlocutory. See *Feigelman v. Meyers*, 476 F.2d 1475, 177 USPQ 530 (CCPA 1973); *United States Treasury v. Synthetic Plastics Co.*, 52 CCPA 967, 341 F.2d 157, 144 USPQ 429 (1965); *Seamless Rubber Co. v. Ethicon, Inc.*, 46 CCPA 950, 268 F.2d 231, 122 USPQ 391 (1959). While certain exceptions to this rule exist in order to further the interests of justice and judicial economy, see e.g., *Stabilisierungsfonds Fur Wein v. Zimmermann-Graeff KG*, 198 USPQ 154 (CCPA 1978); *Toro Co. v. Hardigg Industries Inc.*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Knickerbocker Toy Co., Inc. v. Faultless Storch Co.*, 59 CCPA 1300, 467 F.2d 501, 175 USPQ 417 (1972), we find no reason to extend the exception to the case at bar.



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This court has appellate jurisdiction over interferences by virtue of 28 USC 1542 and 35 USC 141. The latter section limits our jurisdiction to issues involving "the question of priority," which question includes matters ancillary to priority. *Duffy v. Tegtmeier*, 489 F.2d 745, 180 USPQ 317 (CCPA 1974). Thus, we have no jurisdiction to entertain this petition unless it can be said to involve a matter ancillary to priority over which we would have appellate jurisdiction in the normal course of events on appeal from a decision of the board awarding priority. As shown below, this appeal does not involve such a matter.

In support of their position, petitioners rely on *Cook v. Dann*, 522 F.2d 1276, 188 USPQ 175 (CCPA 1975), in which this court rejected a challenge to its jurisdiction under the All Writs Act. In that case, Cook sought a writ of mandamus to direct the board to vacate its decision limiting the scope of discovery in an interference, an issue quite similar to that which we are now confronting. According to petitioners here, "this court held in *Cook v. Dann, Comm'r of Patents* [citation] that it had the authority to issue a writ of mandamus to review a decision by the PTO under 37 CFR 1.287 prior to a determination of priority."

We do not read *Cook* so broadly. The language relied upon here by petitioners was not intended to convey the meaning they wish to ascribe to it. In *Cook*, the court stated "The Patent [and] Trademark Office (PTO) respondents' challenge to our jurisdiction under the All Writs Act (28 U.S.C. § 1651(a)) must be rejected." 522 F. 2d at 1276, 188 USPQ at 176. We were there responding to a suggestion by the Commissioner in the PTO brief that "As previously submitted in the commissioner's opposition to the petition in *Duffy v. Tegtmeier* [citation], the court lacks jurisdiction to issue an order in the nature of

*Appendix—Decision of the Court of Customs  
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*mandamus on the commissioner in a patent case.*" (Emphasis ours.)

Thus, while it may not be clear from the face of the court's opinion in *Cook*, we did not there intend to imply that this court had jurisdiction over the action complained of by Cook. We were there dealing with this court's basic power to act under the All Writs Act in attempting to correct the erroneous interpretation of the law by the PTO to the effect that this court could *never* issue a writ of mandamus to the Commissioner in a patent case. As to the merits in *Cook*, we were of the opinion that, assuming subject matter jurisdiction to be present, we could not find an abuse of discretion on the part of the PTO. In *Cook* we did not decide whether we had jurisdiction.

The recent proliferation of petitions for extraordinary relief has caused us once more to analyze the jurisdictional basis which empowers us to grant such relief. It cannot be assumed that subject matter jurisdiction is present in every case. Even in cases where the writ does not issue, there is a significant difference between dismissing a petition for lack of jurisdiction and denying a petition for want of a good case on the merits.

In the case before us, the action complained of by petitioner would not be subject to review by this court on appeal after a determination of priority by the board. This matter relates to the scope of discovery; a witness has testified that he has certain material relevant to the interference proceeding. The opposing party seeks this material. At this stage of the proceeding, it is not known whether the requested discovery will actually lead to *legally relevant* and *admissible* evidence. This is certainly not a question of priority, and we are of the opinion that it is not ancillary to priority as the case law has developed the meaning of that term. The happenstance that the ordered discovery *might* result in evidence bearing

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and Patent Appeals.*

upon or even establishing priority does not make this issue ancillary to priority.<sup>2</sup>

We therefore hold that we are without power to entertain *this* petition for a writ of mandamus since the matter complained of is not one which would be cognizable before this court on appeal from a decision of the board awarding priority.

The petition is *dismissed*. The motion for oral argument is *denied*.

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<sup>2</sup> In contrast, the question of whether evidence was properly admitted, as well as questions regarding the weight to be accorded evidence, have been held to be ancillary to priority, and, hence, reviewable by this court after a determination and award of priority. *Piel v. Falkner*, 57 CCPA 1132, 426 F.2d 412, 165 USPQ 708 (1970).



SEP 10 1979

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JUNIOR PARTY PATENTEES,

*Petitioners,*

vs.

DONALD W. BANNER, COMMISSIONER OF PATENTS  
AND TRADEMARKS,

MARVIN A. CHAMPION, NORMAN G. TORCHIN, AND  
MICHAEL SOFOCLEOUS, MEMBERS U. S. PATENT AND  
TRADEMARK OFFICE BOARD OF PATENT INTERFERENCE,

*and*

WILLIAM KLEIN, SENIOR PARTY APPLICANT,

*Respondents.*

**BRIEF OF RESPONDENT KLEIN IN OPPOSITION TO  
WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF CUSTOMS AND PATENT APPEALS.**

LLOYD W. MASON,  
JOHN G. HEIMOVICS,  
*Counsel for Respondent.*

LLOYD W. MASON,  
WEGNER, STELLMAN, MCCORD, WILES & WOOD,  
20 North Wacker Drive,  
Chicago, Illinois 60606.

JOHN G. HEIMOVICS,  
The Law Firm of Richard E. Alexander Ltd.  
33 North Dearborn Street,  
Chicago, Illinois 60602,  
*Attorneys for Respondent.*

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IN THE

**Supreme Court of the United States**

OCTOBER TERM, 1979

**No. 79-223**

REID C. GOODBAR AND ARTHUR M. PRESSLEY,  
JUNIOR PARTY PATENTEES,  
*Petitioners,*  
vs.

DONALD W. BANNER, COMMISSIONER OF PATENTS  
AND TRADEMARKS,

MARVIN A. CHAMPION, NORMAN G. TORCHIN, AND  
MICHAEL SOFOCLEOUS, MEMBERS U. S. PATENT AND  
TRADEMARK OFFICE BOARD OF PATENT INTERFERENCE,

*and*

WILLIAM KLEIN, SENIOR PARTY APPLICANT,  
*Respondents.*

**BRIEF OF RESPONDENT KLEIN IN OPPOSITION TO  
WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF CUSTOMS AND PATENT APPEALS.**

*To the Honorable Chief Justice and the Associate Justices of the  
Supreme Court of the United States:*

Respondent Klein respectfully opposes the request for the  
issuance of a Writ of Certiorari to review the order of the United



States Court of Customs and Patent Appeals entered in this proceeding on May 31, 1979.

#### DECISIONS BELOW.

The Board of Patent Interferences in Patent Interference No. 98,935 granted, in part, Klein's motion for discovery on August 17, 1978 in an unreported decision (App. 14). On October 17, 1978, the Board of Interferences reconsidered its order for discovery and reaffirmed in an unreported decision (App. 18).

The Commissioner of Patents and Trademarks affirmed the Board of Interferences in an unreported decision, dated January 15, 1979 (App. 9), which was reviewed and reaffirmed in an unreported decision of February 22, 1979 (App. 13).

The decision of the United States Court of Customs and Patent Appeals of May 31, 1979, reported as *Goodbar et al v. Banner et al*, \_\_\_\_\_ F. 2d \_\_\_\_\_, 202 USPQ 106 (CCPA 1979), dismissed a petition for Writ of Mandamus (App. 1). The Court of Customs and Patent Appeals refused rehearing of the decision in *Goodbar et al v. Banner et al* in an unreported decision of July 19, 1979 (App. 8).

#### JURISDICTION.

The jurisdictional requisites are adequately presented in the Petition.

#### QUESTION PRESENTED.

Is an interlocutory order of the Board of Patent Interferences granting discovery in an interference proceeding an issue within the appellate jurisdiction of the Court of Customs and Patent Appeals?

#### STATEMENT OF THE CASE.

This Petition arises from an administrative proceeding which is still pending in the United States Patent and Trademark Office. The proceeding involves an interference between a patent of the Junior Party, Goodbar et al, and a patent application of the Senior Party, Klein, to determine the issue of inventorship, i.e., which party should be granted an award of priority. The Petitioner is now in the process of taking its testimony to establish its earliest date of alleged invention. Petitioner filed its patent application nearly four months after the patent application of Respondent Klein, and by Patent Office rule, Petitioner (the Junior Party) is required to be the first to take its testimony.

Petitioner's initial witness was Dr. Roger Varin, a former Director of Research and Development of petitioner's assignee.\* On cross-examination, Respondent Klein surprisingly discovered from the testimony of Dr. Varin that he possessed relevant evidence which had not heretofore been produced by Petitioner. Petitioner's witness stated that he had "some things" in his personal file which related to the issues of the interference proceeding (App. 30). Upon demand, Petitioner refused to produce these relevant materials, which materials had been turned over to Petitioner by Dr. Varin only a few days before his testimony (App. 31). Petitioner has conceded throughout this proceeding that the requested subject matter is relevant.

Respondent proceeded under Rules 287(b) and (c) (App. 24) to secure this relevant material. The Board of Patent Interferences (Board) held that Respondent was entitled to the

\* Riegel Textile Corporation is assignee of Goodbar et al Patent No. 3,703,073, and Brunswick Corporation is assignee of Klein patent application Serial No. 262,108, involved herein.



material identified by Petitioner's witness, and adhered to its decision on Petition for Rehearing (App. 14, 18).)

The Commissioner of Patents and Trademarks refused to disturb the decision of the Board, and affirmed its earlier decision after considering a Petition for Reconsideration (App. 9, 13).

After the Commissioner's second decision, Respondent Klein caused a subpoena duces tecum (App. 35) to be served on Reid C. Goodbar and his attorney for the production of "some things". To quash the subpoena, attorney for Goodbar entered into a Stipulation (App. 33) wherein he agreed *without any reservation* to produce the "some things" for inspection and copying by counsel for Respondent Klein in the event Petitioner was not successful in achieving a reversal of the order of the Board and the Commissioner compelling discovery (App. 33, 34).

Petitioner then filed for Writ of Mandamus in the Court of Customs and Patents Appeals (CCPA). The CCPA refused to consider this interlocutory discovery matter because the jurisdiction conferred by statute on the CCPA in interference proceedings is limited to matters relating to priority of inventorship and to matters ancillary thereto (App. 1). The Court of Customs and Patent Appeals adhered to its decision on a Petition for Rehearing (App. 8).

## ISSUES RAISED BY PETITIONER.

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The Petitioner states that there are three reasons for granting the Writ:

1. that the CCPA has subject matter jurisdiction to entertain a Writ of Mandamus and failed to do so;
2. that privileged and confidential information is protected by the court and that the CCPA failed to exercise its power to review the substance of the Writ of Mandamus on the merits; and
3. that there is a clear and substantial conflict between the Second Circuit and the CCPA regarding the Patent and Trademark discovery rule 37 CFR 1.287(c).

## REASONS FOR DENYING WRIT.

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The Petition for Writ of Certiorari should be denied because:

1. An interlocutory order of the Board granting discovery in an interference proceeding is not *subject matter* within the appellate jurisdiction of the Court of Customs and Patent Appeals.
2. No proprietary, confidential or privileged matters are in the requested material, and the consideration of such matters to contest the Board's interlocutory order is not within the subject matter appellate jurisdiction of the CCPA.
3. There is no conflict between the Second Circuit and the CCPA regarding discovery under Rule 37 CFR 1.287(c).

## ARGUMENT.

The present case relates to a single discovery request ordered by the Board in a patent interference to determine which of two parties is the inventor and entitled to an award of priority (35 USC 135). The case presents no issue of public interest or public importance which should induce this Court to grant the Petition. The controversy is between a Junior Party patentee and a Senior Party patentee applicant. The interference is in the early stages of the testimony period. The Board has not made any decision awarding priority. In fact, no evidentiary records have yet been submitted.

### **THE COURT OF CUSTOMS AND PATENT APPEALS DOES NOT HAVE SUBJECT MATTER JURISDICTION OVER THE ISSUES PRESENTED IN THE PETITION FOR WRIT OF MANDAMUS.**

The Petition for Writ of Mandamus below was brought under the All Writs Act, 28 USC 1651(a) which reads as follows:

"The Supreme Court and all courts established by act of Congress may issue all writs necessary or appropriate *in aid of their respective jurisdictions* and agreeable to the usages and principles of law." (Emphasis added.)

The All Writs Act does not grant or define the appellate jurisdiction of the CCPA. In interference proceedings, the appellate jurisdiction granted to the CCPA is set out in 35 USC 141, which in pertinent part states:

"A party to an interference dissatisfied with the decision of the board of patent interferences on *the question of priority* may appeal to the United States Court of Customs and Patent Appeals." (Emphasis ours.) (App. 20)

The authority of an appellate court to issue writs of mandamus is restricted by statute to those cases in which the writ is in aid of the subject matter jurisdiction of the appellate court. Thus, jurisdiction of the subject matter to which the writ relates is essential, whether an appeal is perfected or not.

As this Court stated in *Roche v. Evaporated Milk Association*, 319 U. S. 21 (1943) at page 25:

"As the jurisdiction of the circuit court of appeals is exclusively appellate, its authority to issue writs of mandamus is restricted by statute to those cases in which the writ is in aid of that jurisdiction. Its authority is not confined to the issuance of writs in aid of a jurisdiction already acquired by appeal but extends to those cases which are within its appellate jurisdiction although no appeal has been perfected."

Petitioner does not contend that the interlocutory discovery order relates to *priority* or to a matter *ancillary to priority*. Petitioner's witness testified that the "some things" relate to this interference proceeding. The issues to which the "some things" relate await their disclosure. Only Petitioner and his witness are privy to this information. No decision on priority has been rendered by the Board. The CCPA has no question of priority to consider (App. 7).

The *subject matter* is the interlocutory discovery order of the Board identifying the "some things", unknown to Respondent, which are not now part of the evidence or record below, and which may (or may not) later be part of the proof relating to priority. Certainly this subject matter is not a decision on a question of priority which is within the appellate jurisdiction of the CCPA, as designated by statute.

This piecemeal attempt to review interlocutory discovery orders should be avoided in the interest of orderly administrative and judicial proceeding. This is the reason for the sentence in 37 CFR 1.287(c) stating:



"An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority." (App. 24.)

At that time, the question of priority will be reviewed together with the supporting evidence and other matters in the record to determine whether reversible error is present.

This is precisely what happened in *Cochran v. Kresock*, 530 F. 2d 385, 188 USPQ 553 (CCPA 1976), cited by Petitioner (Petition Pg. 7). The Board's decision awarding priority was appealed to the CCPA. The CCPA assumed jurisdiction (35 USC 141) because the question of priority was the precise issue on appeal, which issue is lacking in the instant CCPA proceeding. The request in *Cochran* for additional discovery under 37 C. F. R. 1.287(c), denied by the Board, was reviewed (with other parts of the record) by the CCPA to ascertain whether reversible error was present bearing on the issue of priority.

The decision in *Cook v. Danni, Comm'r of Pats.*, 522 F. 2d 1276, 188 USPQ 175 (CCPA 1975) is clearly distinguished by the CCPA in its decision (App. 5, 6).

The CCPA herein recognized its lack of subject matter jurisdiction to consider an interlocutory discovery matter not relating to priority, and therefore correctly dismissed the Petitioner's Petition for Writ of Mandamus.

**PETITIONER'S COURSE OF CONDUCT BELIES  
THE EXISTENCE OF PROPRIETARY,  
CONFIDENTIAL AND PRIVILEGED DOCUMENTS  
IN THE REQUESTED MATERIAL.**

Petitioner's argument alleging failure to protect proprietary, privileged and confidential matters is unsound. The issue presented does not relate to an award of priority, as pointed out above; jurisdiction is lacking in the CCPA of this subject matter at this time under the mandamus proceeding.

Petitioner has attempted to set up a "straw man" in its constant reference to proprietary, confidential and/or privileged

matters. Petitioner's Witness (Dr. Varin) testified on cross-examination that he had a personal file of carbon copies of things that he wrote, and that "some things" in the file related to this proceeding (App. 30). He was a principal witness of Petitioner. His testimony concerned Petitioner's alleged conception and reduction to practice of the invention at issue (Petition, pg. 3).

Respondent Klein asked for the "some things" in the file (App. 31).

After presenting testimony and documents relating to its claimed invention via Dr. Varin, Petitioner now contends that these "some things" are special materials—proprietary, confidential, privileged—even though they relate to the issue on which Petitioner produced its proof on direct examination. Petitioner cannot produce some documents on the crucial issues of the interference, while concealing other relevant documents on the same issues by contentions of proprietary, confidential and privileged matters.

More importantly, Petitioner has never invoked, or sought to invoke, the provisions of Fed. R. Civ. P. 26(c). No protective order has been sought from any Court to safe-guard disclosure of the "some things".

Furthermore, Petitioner has now entered into a stipulation (App. 33) agreeing to disclose the "some things" to Respondent in the event Petitioner is not successful in reversing the order of the Board and the Commissioner.

Respondent is entitled to these "some things" to adequately ventilate this interference proceeding.

**NO CONFLICT EXISTS BETWEEN CCPA  
DECISION AND SHATTUCK CASE.**

Petitioner contends that the decision in *Shattuck v. Hoegl*, 555 F. 2d 1118, 194 USPQ 405 (2nd Cir. 1977) is in conflict with the instant CCPA decision. In *Shattuck*, additional dis-

covery, requested under 35 USC 24 in an interference, was denied to party Shattuck. The portion of the decision cited by Petitioner (Petition, pg. 8) is dicta, and even that is not in conflict.

The full text of the Petitioner's *partially* quoted paragraph from this case, *Id.* at 1121, 408 reads:

"A party in the position of IBM is not left without a remedy. The Patent Office has recently adopted a rule under which discovery may be conducted in interference proceedings. Moreover, a party disappointed by an interference proceeding has access to two Article III courts. An appeal may be taken to the Court of Customs and Patent Appeals. If that court finds that discovery against a party should have been ordered, it can vacate the decision of the Patent Office. *Alternatively, the losing party may seek review in a district court, in which a trial de novo will be held. In such a proceeding, the full panoply of discovery procedures provided by Rule 26 is available, and further review is possible.* Inasmuch as the chosen forum for review will be able to remedy any error in the discovery proceedings, there is no reason to allow this interlocutory appeal." (Italicized portion deleted by Petitioner.)

The Second Circuit accurately stated that if the losing party to a patent interference was dissatisfied with the award of priority by the Board, it had two courses of action:

- (1) an appeal to the CCPA to have the award of priority vacated as the award was improperly made because of discovery related errors committed by the Board going to the issue of priority; or,
- (2) a trial de novo in a District Court where the totality of discovery procedures provided by Rule 26, Fed. R. Civ. P. is available.

The Second Circuit did not make, or intend to make, a determination of the bounds of jurisdiction of the CCPA; it was only restating the jurisdiction of the CCPA under 35 USC 141 (App. 20) and the District Court under 35 USC 146 (App. 21).

The facts, decision and dicta of the *Shattuck* case were presented to the CCPA by means of Petitioner's Petition for Rehearing and Respondent's Opposition thereto. In denying the Petition on Rehearing, the CCPA obviously recognized correctly that there was no conflict between the Second Circuit and itself.

Furthermore, the limits of CCPA appellate jurisdiction was not in issue in the *Shattuck* case. The *Shattuck* case held that in an interference proceeding the Court of Appeals for the Second Circuit lacked jurisdiction on appeal from a collateral discovery order of the District Court which order denied discovery against a deponent having the status of *a party* in the interference.

Since the issue decided in the CCPA decision differs from the issue decided by the Second Circuit, no conflict exists in fact between the two Courts.

#### REQUEST FOR FEES AND COSTS.

It is respectfully requested that:

(1) Respondent Klein be awarded fees and costs commensurate with providing in his Appendix all the opinions of the courts and administrative agencies in this case since this is a burden that Petitioner must bear in accordance with Supreme Court Rule 23(1)(i); and

(2) Respondent Klein be awarded attorneys fees and costs in accordance with Supreme Court Rules 56(4) and 57(7) since the Petition for Writ of Certiorari has no merit and contains no grounds for the granting thereof.



# CONCLUSION.

The Petition for a Writ of Certiorari should be denied and fees and costs be awarded to Respondent Klein together with such other relief as the Supreme Court in its sound discretion may determine.

Respectfully submitted,

LLOYD W. MASON,  
JOHN G. HEIMOVICS,  
*Counsel for Respondent.*

LLOYD W. MASON,  
WEGNER, STELLMAN, MCCORD, WILES & WOOD,  
20 North Wacker Drive,  
Chicago, Illinois 60606.

JOHN G. HEIMOVICS,  
The Law Firm of Richard E. Alexander Ltd.  
33 North Dearborn Street,  
Chicago, Illinois 60602.  
*Attorneys for Respondent.*

September 10, 1979

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**APPENDIX.**

**DECISION OF UNITED STATES COURT OF CUSTOMS  
AND PATENT APPEALS.**

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

REID C. GOODBAR and ARTHUR M.  
PRESLEY, Junior Party Patentees,  
*Petitioner,*

vs.

DONALD W. BANNER, Commissioner of  
Patents and Trademarks,

MARVIN A. CHAMPION, NORMAN G.  
TORCHIN, and MICHAEL SOFOCLE-  
OUS, Members U. S. Patent and  
Trademark Office Board of Patent  
Interference, and

WILLIAM KLEIN, Senior Party  
Applicant,

*Respondents.*

Appeal No. 79-555.

On Petition for Writ  
of Mandamus.

Interference No.  
98,935.

DECIDED: May 31, 1979

Before MARKEY, *Chief Judge*, RICH, BALDWIN, LANE,\* and  
MILLER, *Associate Judges*.

RICH, *Judge*.

Petitioners seek a writ of mandamus, directing the Patent and Trademark Office (PTO) Board of Patent Interferences (board) to vacate its order compelling petitioners to produce for inspection and copying certain documents in connection with interference No. 98,935. Respondents are the Commissioner of Pat-

\* Judge Lane took part in the consideration and decision of this matter but died before the decision was announced.

App. 2

CCPA Decision May 31, 1979

ents and Trademarks (Commissioner), the board, and Klein, petitioners' interference adversary. Oppositions to the petition have been filed by the Commissioner and Klein.

This petition was kindled by testimony elicited from Dr. Roger Varin, former Director of Research for Riegel Textile Corporation, assignee of the junior party petitioners' patent. This testimony was taken during the junior party petitioners' testimony-in-chief period. Specifically, on cross-examination, Dr. Varin testified that he kept a file of correspondence generated while he was employed by Riegel. After testifying that he was familiar with the contents of the file, the following was elicited:

Q. Did you find anything relating to this proceeding?

A. There were some things.

As a result of this testimony, respondent Klein filed a Motion for Production of Documents Under 37 CFR 1.287(b) and (c), requesting, inter alia, the production of Dr. Varin's correspondence file for inspection and copying.

Petitioners opposed production of the file. They asserted that the request was overly broad and indefinite and would require the production of documents containing confidential and proprietary information. They also stated that Klein has failed to show that production of the file would be in the "interests of justice" as required by 37 CFR 1.287(c).

The board granted respondent Klein's motion, but only to the extent that the documents to be produced were the ones referred to in Dr. Varin's testimony as being related to this proceeding. The board stated:

With regard to requests 2, 4 and 5 [request 5 is the only one at issue here], the motion is granted as being in the "interest of justice". As to request 2, there is no ostensible objection. As to requests 4 and 5, the motion paper indicates that Klein ascertained the probable existence of the photographs [the subject of request 4] and the "somethings" [sic, some things] during cross-examination

App. 3

CCPA Decision May 31, 1979

and their existence could not have been determined earlier by inspecting the documents served under § 1.287(a). Also request 5 is considered properly limited to the subject matter of the counts in issue inasmuch as it is limited to "somethings" [sic, some things] related to this proceeding. [Emphasis ours.]

The board adhered to this decision on reconsideration.

Relief was requested from the Commissioner by a petition to reverse the decision of the board. Commissioner Banner denied the petition with the following comments:

Petitioners maintain that the board should have denied request 5 because the documents sought thereby were not limited in scope to a relevant time period. It is apparent that petitioners have misinterpreted the board's order. A fair reading of the board's order, taken in light of the motion and opposition before the board and Dr. Varin's cross-examination, demonstrates that the board only ordered petitioners to make discovery of the "some things" in his file which relate "to this proceeding," or as respondent's counsel put it those things which "relate to this subject matter."

Since the board's order properly limits the documents, both as to scope of time and subject matter, it follows that the board correctly ruled on respondent's request 5. [Emphasis ours.] Accordingly, the decision of the board granting request 5 is affirmed [emphasis in original].

Petitioners assert an abuse of discretion on the part of the board in granting the request, and on the part of the Commissioner in refusing to reverse the board's decision. They claim, as they did before the board, that the request is overly broad and indefinite, and that the material sought to be discovered is proprietary and confidential. We are asked to issue mandamus to vacate the decision of the board and its order requiring the production of documents as per request 5.

Petitioners have also, by motion, requested oral argument on their Petition for Mandamus. Respondent Klein opposes the motion.



## OPINION.

1. *Request for Oral Argument.*

The motion for oral argument is denied. Oral arguments on petitions for extraordinary relief are not granted unless directed by this court. See CCPA Rule 7.1(b). The court does not find oral argument helpful in cases such as this where the issues are clear and the case is not complex. Cf. *United States v. Watson, Judge, United States Customs Court and Michelin Tire Co.*, Appeal No. 79-17, argued May 2, 1979 (oral argument granted on Government's motion due to complexity and importance of issues).

2. *The Requested Writ.*

Under 28 USC 1651(a), the All Writs Act, this court, as one "established by Act of Congress," has the power to issue all writs "necessary or appropriate in aid of [our] jurisdiction" (emphasis ours). *Loshbough v. Allen*, 56 CCPA 913, 404 F. 2d 1400, 160 USPQ 204 (1969). The All Writs Act is not an independent grant of appellate jurisdiction, and, therefore, the appellate jurisdiction which the writs are "in aid of" must have some other basis. *Roche v. Evaporated Milk Assoc.*, 319 U. S. 21, 23-26 (1943). This basis, of course, must be found within the *subject matter jurisdiction* of this court, since the All Writs Act does not bestow upon this court the power to adjudicate issues falling outside of this jurisdiction. The crucial question is thus whether we have subject matter jurisdiction over the issues presented in the petition for extraordinary relief. For this reason, it is incumbent upon any petitioner seeking such relief in this court to demonstrate that we have subject matter jurisdiction over the issue involved.

The present petition arises out of an interference. Specifically, it is the result of a decision of the board which granted the

senior party's request for additional discovery, made by motion under 37 CFR 1.287(b) and (c). Since there is no appeal from decisions of the board on motions, any support for the jurisdiction of this court must be found elsewhere.<sup>1</sup>

This court has appellate jurisdiction over interferences by virtue of 28 USC 1542 and 35 USC 141. The latter section limits our jurisdiction to issues involving "the question of priority," which question includes matters ancillary to priority. *Duffy v. Tegtmeyer*, 489 F. 2d 745, 180 USPQ 317 (CCPA 1974). Thus, we have no jurisdiction to entertain this petition unless it can be said to involve a matter ancillary to priority over which we would have appellate jurisdiction in the normal course of events on appeal from a decision of the board awarding priority. As shown below, this petition does not involve such a matter.

In support of their position, petitioners rely on *Cook v. Dann*, 522 F. 2d 1276, 188 USPQ 175 (CCPA 1975), in which this court rejected a challenge to its jurisdiction under the All Writs Act. In that case, Cook sought a writ of mandamus to direct the board to vacate its decision limiting the scope of discovery in an interference, an issue quite similar to that which we are now confronting. According to petitioners here, "this court held in *Cook v. Dann, Comm'r of Patents* [citation] that it had the authority to issue a writ of mandamus to review a decision by the PTO under 37 CFR 1.287 prior to a determination of priority."

1. We, like all other federal appellate courts, are bound by the final judgment rule which limits our jurisdiction to final decisions of the PTO appeal boards, as contrasted with decisions which are merely interlocutory. See *Feigelman v. Meyers*, 476 F. 2d 1475, 177 USPQ 530 (CCPA 1973); *United States Treasury v. Synthetic Plastics Co.*, 52 CCPA 967, 341 F. 2d 157, 144 USPQ 429 (1965); *Seamless Rubber Co. v. Ethicon, Inc.*, 46 CCPA 950, 268 F. 2d 231, 122 USPQ 391 (1959). While certain exceptions to this rule exist in order to further the interests of justice and judicial economy, see e.g., *Stabilisierungsfonds Fur Wein v. Zimmermann-Graeff KG*, 198 USPQ 154 (CCPA 1978); *Toro Co. v. Hardigg Industries Inc.*, 549 F. 2d 785, 193 SPQ 149 (CCPA 1977); *Knickerbocker Toy Co., Inc. v. Faultless Starch Co.*, 59 CCPA 1300, 467 F. 2d 501, 175 USPQ 417 (1972), we find no reason to extend the exception to the case at bar.



We do not read *Cook* so broadly. The language relied upon here by petitioners was not intended to convey the meaning they wish to ascribe to it. In *Cook*, the court stated "The Patent [and] Trademark Office (PTO) respondents' challenge to our jurisdiction under the All Writs Act (28 U. S. C. § 1651(a)) must be rejected." 522 F. 2d at 1276, 188 USPQ at 176. We were there responding to a suggestion by the Commissioner in the PTO brief that "As previously submitted in the commissioner's opposition to the petition in *Duffy v. Tegtmeyer* [citation], the court lacks jurisdiction to issue an order in the nature of mandamus on the commissioner in a patent case." (Emphasis ours.)

Thus, while it may not be clear from the face of the court's opinion in *Cook*, we did not there intend to imply that this court had jurisdiction over the action complained of by Cook. We were there dealing with this court's basic power to act under the All Writs Act in attempting to correct the erroneous interpretation of the law by the PTO to the effect that this court could *never* issue a writ of mandamus to the Commissioner in a patent case. As to the merits in *Cook*, we were of the opinion that, assuming subject matter jurisdiction to be present, we could not find an abuse of discretion on the part of the PTO. In *Cook* we did not decide whether we had jurisdiction.

The recent proliferation of petitions for extraordinary relief has caused us once more to analyze the jurisdictional basis which empowers us to grant such relief. It cannot be assumed that subject matter jurisdiction is present in every case. Even in cases where the writ does not issue, there is a significant difference between dismissing a petition for lack of jurisdiction and denying a petition for want of a good case on the merits.

In the case before us, the action complained of by petitioner would not be subject to review by this court on appeal after a determination of priority by the board. This matter relates to the scope of discovery; a witness has testified that he has certain

material relevant to the interference proceeding. The opposing party seeks this material. At this stage of the proceeding, it is not known whether the requested discovery will actually lead to *legally relevant* and *admissible* evidence. This is certainly not a question of priority, and we are of the opinion that it is not ancillary to priority as the case law has developed the meaning of that term. The happenstance that the ordered discovery *might* result in evidence bearing upon or even establishing priority does not make this issue ancillary to priority.<sup>2</sup>

We therefore hold that we are without power to entertain *this* petition for a writ of mandamus since the matter complained of is not one which would be cognizable before this court on appeal from a decision of the board awarding priority.

The petition is *dismissed*. The motion for oral argument is *denied*.

2. In contrast, the question of whether evidence was properly admitted, as well as questions regarding the weight to be accorded evidence, have been held to be ancillary to priority, and, hence, reviewable by this court after a determination and award of priority. *Piel v. Falkner*, 57 CCPA 1132, 426 F. 2d 412, 165 USPQ 708 (1970).

DECISION ON PETITION FOR REHEARING IN THE  
COURT OF CUSTOMS AND PATENT APPEALS.

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Thursday, July 19, 1979

Before: MARKEY, *Chief Judge*, RICH, BALDWIN and MILLER,  
*Associate Judges*; Senior Judge COWEN, UNITED STATES  
COURT OF CLAIMS, and *Chief Judge Re*, UNITED STATES  
CUSTOMS COURT.

\* \* \* \* \*

PETITION FOR REHEARING

No. 79-555. REID C. GOODBAR and ARTHUR M. PRESLEY v.  
DONALD W. BANNER, Commissioner of Patents and Trade-  
marks, MARVIN A. CHAMPION, NORMAN G. TORCHIN and  
MICHAEL SOFOCLEOUS, Members of Board of Patent Inter-  
ferences and WILLIAM E. KLEIN. The petition for rehearing is  
denied.

COMMISSIONER'S DECISION DATED JANUARY 15,  
1979

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

January 15, 1979

Goodbar et al.,

*Petitioners*

v.

Klein,

*Respondent.*

Decision on Petition  
Interference  
No. 98,935

Petitioners seek review (Paper No. 88) of a decision of the Board of Patent Interferences (Paper No. 81), adhered to on reconsideration (Paper No. 86), granting respondent additional discovery under 37 CFR 1.287(c). Respondent has opposed (Paper No. 91).<sup>1</sup>

Petitioners, recognizing the provisions of the last sentence of 37 CFR 1.287(c),<sup>2</sup> also request that the Commissioner waive those provisions pursuant to his authority under 37 CFR 1.183.<sup>3</sup> The petition will be considered on the merits, not because the case presents any "extraordinary situation" within the meaning of 37 CFR 1.183, but in view of petitioners' apparent misunderstanding of the meaning of the decision of the board granting additional discovery.<sup>4</sup>

1. Respondent timely requested an extension of time within which to oppose the petition (Paper No. 90). In view of the circumstances set forth in the request and any lack of opposition thereto by petitioners, the request for an extension of time is granted.

2. "An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority."

3. "In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner. . . ."

4. The authority of the Commissioner to consider the petition on the merits notwithstanding the last sentence of 37 CFR 1.287(c) and apart from 37 CFR 1.183 is clear. 35 U.S.C. 6; *Kingsland v. Carter Carburetor Corp.*, 168 F.2d 565, 77 USPQ 499 (D.C. Cir. 1948).

*Background*

The interference is presently in petitioners' testimony period, petitioners being the junior party. During cross-examination of one of petitioners' witnesses, Dr. Roger P. Varin, it became apparent that certain photographs "taken in connection with the patent application" may exist. Dr. Varin also indicated on cross-examination that a file now apparently in the possession of his former employer (petitioners' assignee) contains "some things" which relate "to this proceeding" which Dr. Varin did not believe had been previously brought to the attention of respondent. Counsel for respondent then asked for production of relevant documents from the file:

Respondent's Counsel: "I ask that those be produced also."

Petitioners' Counsel: "All the documents?"

Respondent's Counsel: "Those that relate to this subject matter Counsel."

Petitioners' Counsel: "The request is refused."

Cross-examination was then suspended and respondent filed a motion for additional discovery under 37 CFR 1.287(c) seeking, *inter alia*, the photographs<sup>5</sup> and relevant portions of Dr. Varin's file.<sup>6</sup>

The board granted respondent's motion, indicating (Paper No. 81, page 3):

"As to requests 4 and 5, the motion paper indicates that Klein ascertained the probable existence of the photographs and the 'somethings' during cross-examination and their existence could not have been determined earlier by inspecting documents served under § 1.287(a). Also re-

5. Request 4 of the motion "requests that Party Goodbar et al. produce the photographs which Dr. Varin states, 'I believe that I recall having some pictures taken in connection with the patent application.'" Paper No. 77, page 19.

6. Request 5 of the motion "requests that Party Goodbar et al. produce Dr. Varin's file and its contents identified by Dr. Varin during his deposition and referred to at deposition pages 180 and 181." Paper No. 77, page 20.

quest 5 is considered properly limited to the subject matter of the counts in issue inasmuch as it is limited to 'somethings' relating to this proceeding."

In its decision on reconsideration (Paper No. 86), the board further indicated:

"Nor will we limit request 5 to the scope of time requested by Goodbar et al. inasmuch as their witness testified that the file contained 'somethings' relevant to this proceeding. Because of this testimony, we consider that Klein is entitled as a matter of right to those 'somethings.'"

*Discussion*

Initially, while it is noted that there is one sentence in the petition (Paper No. 88, page 4) relating to the board's decision granting respondent's request 4, no serious argument is made that the board committed any error. A review of the record demonstrates that the board committed no abuse of discretion in granting request 4. Accordingly, the decision granting request 4 is *affirmed*.

Petitioners maintain that the board should have denied request 5 because the documents sought thereby were not limited in scope to a relevant time period. It is apparent that petitioners have misinterpreted the board's order. A fair reading of the board's order, taken in light of the motion and opposition before the board, and Dr. Varin's cross-examination, demonstrates that the board only ordered petitioners to make discovery of the "some things" in his file which relate "to this proceeding," or as respondent's counsel put it those things which "relate to this subject matter."

Since the board's order properly limits the documents, both as to scope of time and subject matter, it follows that the board correctly ruled on respondent's request 5. Accordingly, the decision of the board granting request 5 is *affirmed*.



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Commissioner's Decision January 15, 1979

*Decision*

The petition (Paper No. 81) is *denied* on the merits.

*Order*

Petitioners are ordered to make available to respondent the documents encompassed by requests 4 and 5 within one (1) month from the date of this decision and, as the board required, "to indicate, under oath, full compliance with the order" (Paper No. 81, page 3). Prompt and full compliance with this order may render it unnecessary to continue cross-examination of Dr. Varin. However, nothing in this opinion should be taken as limiting in any way the right of respondent to continue cross-examination of Dr. Varin to determine whether petitioners have in fact permitted respondent to inspect and copy the photographs and "some things" which relate "to this proceeding" referred to in Dr. Varin's previous testimony.

The interference is being returned to the jurisdiction of the board. The Patent Interference Examiner's attention is directed to his order of September 15, 1978 (Paper No. 81).

/s/ DONALD W. BANNER

Donald W. Banner

*Commissioner of Patents and  
Trademarks*

PENNIE, EDMONDS, MORTON, TAYLER  
& ADAMS

330 Madison Avenue

New York, New York 10017

*Attorneys for Petitioners*

JOHN G. HEIMOVICS

BRUNSWICK CORPORATION

One Brunswick Plaza

Skokie, Illinois 60076

*Attorneys for Respondent*

App. 13

COMMISSIONER'S DECISION DATED

FEBRUARY 22, 1979

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

February 22, 1979

GOODBAR, et al.,

*Petitioners,*

vs.

KLEIN,

*Respondent.*

Decision on Request  
for Reconsideration

Interference No. 98,935

Goodbar et al. have presented a request for reconsideration (Paper No. 94) seeking modification of a decision on petition (Paper No. 92).

The request for reconsideration has been reviewed. Nothing contained in the request, however, justifies the making of any change in the decision on petition. Accordingly, the request for reconsideration is *denied*.

/s/ DONALD W. BANNER

Donald W. Banner

*Commissioner of Patents and  
Trademarks*

Copies to:

PENNIE, EDMONDS, MORTON, TAYLER,  
& ADAMS

330 Madison Avenue

New York, New York 10017

*Attorneys for Petitioners*

JOHN G. HEIMOVICS

BRUNSWICK CORPORATION

One Brunswick Plaza

Skokie, Illinois 60076

*Attorney for Respondent*

BOARD'S ORDER DATED AUGUST 17, 1978,  
PAPER NO. 81

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Interferences

Patent Interference No. 98,935

GOODBAR et al.

vs.

KLEIN

On July 18, 1978, Klein filed a motion for additional discovery pursuant to 37 CFR 1.287(c) (Paper No. 77). Goodbar et al. stand opposed (Paper No. 80).

In the motion, Klein requests that we order Goodbar et al. to make available for inspection and copying the documents and things encompassed by requests 1 to 22. Klein requests, inter alia, (1) Production of the original diaries of Dr. Varin covering the period from August 12, 1968 until March, 1971 when Dr. Varin left Riegel; (2) Production of documents from Riegel records showing the last known location of James A. Lindsay; (4) Production of the photographs taken in connection with the Goodbar et al. patent application; (5) Production of "some-things" relating to this proceeding from Dr. Varin's file and its contents identified by Dr. Varin during his deposition and referred to at deposition pages 180 and 181; and (6) Production of all weekly progress reports relating to the Riegel anti-static fabric project.

The proceeding is presently at the stage of Goodbar et al.'s testimony-in-chief; Klein's time for cross-examination of the

Board's Order August 17, 1978

junior party's witnesses having been suspended. The motion under consideration was filed after Goodbar et al. refused to make available to Klein documents and things requested by Klein during cross-examination. Cf. 37 CFR 1.287(b).

Discovery under § 1.287(c) may be ordered where it is demonstrated that (i) the existence of *relevant* documents was ascertained under § 1.287(b) during the cross-examination of the junior party's witnesses, (ii) the party's request for the documents under § 1.287(b) was refused and (iii) the motion is seasonably and timely filed. Cf. *Schubert v. McKernan*, 188 USPQ 496 (Bd. Pat. Int. 1975).

In addition, the demonstration should also include a showing of "sufficient cause" when as here the motion is filed after the close of "the period for preparation for testimony". This should include a showing of sufficient facts and circumstances which would reasonably lead the Board to conclude that the existence of the documents sought in the requests could not have been previously ascertained so that a motion could have been seasonably and timely filed. Accordingly, the motion as to requests 7, 12, 13 and 15 to 22, which requests are directed to the issue of derivation, is dismissed as being belatedly filed outside of the period for preparation for testimony in the absence of a showing of such "sufficient cause".

Moreover, with regard to requests 1, 3, and 6 to 22, the motion for additional discovery is *denied* as not being in the "interest of justice". The requests are considered indefinite and too broad in that they go beyond the scope of the subject matter of the counts in issue. *Ziembra v. Richter et al.*, 189 USPQ 491 (Bd. Pat. Int. 1975). The counts are directed to a specific method of drawing and blending fibers while the requested discovery is directed to documents concerning the "Riegel anti-static fiber project". Likewise requests 7, 12, 13 and 15 to 22 are in no way limited in scope to the time period of any possible communications with the junior party.



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*Board's Order August 17, 1978*

Also from the motion, it appears that Klein is on no more than a fishing expedition inasmuch as the explanation in the motion paper lacks the necessary degree of specificity for establishing that the granting of the motion would be in the interest of justice. Considering the length of time spent on cross-examination, nowhere in the motion paper has Klein indicated that he has ascertained with the requisite degree of certainty the relevance of the requested discovery to any issue at bar. The mere conclusionary statement that the requested documents are material and relevant to this proceeding is not considered sufficient to demonstrate such relevance as to justify our ordering discovery.

With regard to requests 2, 4 and 5, the motion is granted as being in the "interest of justice". As to request 2, there is no ostensible objection. As to requests 4 and 5, the motion paper indicates that Klein ascertained the probable existence of the photographs and the "somethings" during cross-examination and their existence could not have been determined earlier by inspecting the documents served under § 1.287(a). Also request 5 is considered properly limited to the subject matter of the counts in issue inasmuch as it is limited to "somethings" relating to this proceeding.

It is ordered that on or before September 17, 1978 Goodbar et al. make available to Klein for inspection and copying the documents encompassed by requests 2, 4 and 5 and to indicate, under oath, full compliance with the order.

In the interest of orderly procedure, the times are extended as follows:

For Klein to complete cross-examination of Goodbar et al witnesses to close October 1, 1978.

Time for service under Rule 287(a) by Klein of documents and lists to close October 10, 1978.

Testimony of Klein to close November 10, 1978.

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*Board's Order August 17, 1978*

Time for service under Rule 287(a) by Goodbar et al of documents and lists in rebuttal to close November 15, 1978.

Rebuttal testimony of Goodbar et al to close December 6, 1978.

Time for filing and serving the record to close January 6, 1979.

MARVIN A. CHAMPION  
Marvin A. Champion,  
*Examiner of Interferences*

NORMAN G. TORCHIN,  
Norman G. Torchin,  
*Examiner of Interferences*

MICHAEL SOFOCLEOUS  
Michael Sofocleous,  
*Acting Examiner of Interferences*

Board of Patent  
Interferences



**BOARD'S ORDER DATED OCTOBER 17, 1978,  
PAPER NO. 86**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Interferences

Patent Interference No. 98,935

Goodbar et al. v. Klein

On September 7, 1978, Goodbar et al. filed a request for reconsideration (Paper No. 82). Klein stands opposed (Paper No. 85).

The request is granted to the extent that we have reviewed the order complained of. No new arguments or reasons have been presented to indicate that the granting of discovery to Klein was in error. We do not consider that Goodbar et al.'s bare allegation concerning the non relevance of the documents encompassed by request 4 constitutes a sufficient reason, in and of itself, for denying discovery of them to Klein. Nor will we limit request 5 to the scope of time as requested by Goodbar et al. inasmuch as their witness testified that the file contained "some-things" relevant to this proceeding. Because of this testimony, we consider that Klein is entitled as a matter of right to those "somethings".

Accordingly, the time for Goodbar et al. to make available to Klein for inspection and copying the documents encompassed by requests 4 and 5 and to indicate under oath the last known location of John A. Lindsey is reset to close on October 25, 1978.

**Board's Order October 17, 1978**

The times vacated in Paper No. 84 are reset as follows:

For Klein to complete cross-examination of Goodbar et al. witnesses to close November 15, 1978.

Time for service under Rule 287(a) by Klein of documents and lists to close November 24, 1978.

Testimony of Klein to close December 24, 1978.

Time for service under Rule 287(a) by Goodbar et al. of documents and lists in rebuttal to close January 5, 1979.

Rebuttal testimony of Goodbar et al. to close January 20, 1979.

Time for filing and serving the record to close February 20, 1979.

MARVIN A. CHAMPION  
Marvin A. Champion,  
*Examiner of Interferences*

NORMAN G. TORCHIN  
Norman G. Torchin,  
*Examiner of Interferences*

MICHAEL SOFOCLEOUS  
Michael Sofocleous,  
*Acting Examiner of Interferences*

Board of Patent  
Interferences

## UNITED STATES CODE

## TITLE 35—PATENTS

CHAPTER 13—REVIEW OF PATENT AND TRADEMARK  
OFFICE DECISION

Sec.

141. Appeal to Court of Customs and Patent Appeals.

142. Notice of appeal.

146. Civil action in case of interference.

(Patent Act of July 19, 1952, Public Law 593, 82d Cong., 2d sess., ch. 950; 66 Stat. 792, with notice as to subsequent amendments.)

## § 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

## § 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent and

## 35 USC 142, 146

Trademark Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints. (Amended January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

## § 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary

party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law. (Amended January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

## 37 CODE OF FEDERAL REGULATIONS

§ 1.287 entitled "Discovery";

§ 1.243 entitled "Motions Before the Board of Patent Interferences";

§ 1.245 entitled "Extension of Time"

(C. F. R. revised as of July 1, 1977; effective until August 1, 1978)

**§ 1.287 Discovery.**

(a)(1) Each party who expects to take testimony must serve on each opposing party who requests service the following:

(i) A copy of each document in his possession, custody, or control and upon which he intends to rely,

(ii) A list of and a proffer of reasonable access to things in his possession, custody, or control and upon which he intends to rely, and

(iii) A list giving the names and addresses of all persons whom he intends to call as witnesses and indicating the relationship of each person to the invention in issue.

(2) Dates for compliance with paragraph (a)(1) of this section will be set in accordance with the following:

(i) The date by which all parties may request service shall be not less than 10 days from the date of the order setting testimony times;

(ii) The date for service by all junior parties shall be not less than 30 days from the date of the order setting such times;

(iii) The date for service by the senior party shall be not less than 10 days from the date set for the close of testimony in chief of all junior parties.

(3) Where more than two parties are involved and one of the junior parties is not entitled to take testimony as to a more



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37 CFR 1.287

senior party, the requirements of paragraphs (a)(1) and (2) of this section shall not be applicable as between such parties.

(b) The provisions of paragraph (a) of this section are without prejudice to the right of a party, where appropriate, to obtain production of documents or things during cross-examination of an opponent's witness or during his own period for rebuttal testimony.

(c) Upon motion (§ 1.243) brought by a party during the period for preparation for testimony, or thereafter as authorized under § 1.245, and upon a showing that the interest of justice so requires, the Board of Patent Interferences may order additional discovery as to matters under the control of a party within the scope of the discovery rules of the Federal Rules of Civil Procedure, specifying the terms and conditions of such additional discovery. An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority.

(d)(1) A party will not be permitted to rely on any document or thing in his possession, custody, or control, or on any witness, not listed and served by that party as required by paragraph (a) of this section, except upon a promptly filed motion accompanied by the proposed additional documents or lists together with a showing of sufficient cause as to why they were not served by the date set pursuant to paragraph (a) of this section.

(2) Any failure to comply with an order under the provisions of paragraph (c) of this section may be considered by the Board of Patent Interferences as basis for applying appropriate restrictions against the party failing to comply, for holding certain facts to have been established, and in an appropriate case for awarding priority against him, or for taking such other action as may be deemed appropriate.

(e) The parties may by agreement among themselves modify any of the foregoing requirements consistent with the schedule

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37 CFR 1.287, 1.243

of times for taking testimony and filing the record. In the absence of such agreement, discovery will not be permitted prior to the period set for the preparation for testimony.

[36 FR 8733, May 12, 1971]

**§ 1.243 Motions before the Board of Patent Interferences.**

(a) Motions relating to matters other than those specified in § 1.231 will be determined by a patent interference examiner or the Board of Patent Interferences, as may be deemed appropriate. Such motions shall be made in writing and shall contain a full statement of the action sought and the grounds therefor, and satisfactory proof of any facts required must accompany the motion. Oral hearings will not be held except on order of a patent interference examiner or Board of Patent Interferences. Briefs or memoranda in support of such motions shall accompany the motion. Any opposition to the motion, together with any brief or memorandum in support thereof, shall be filed within 20 days from the date of service of the motion unless some other date is set by the patent interference examiner.

(b) Typewritten briefs may be used in connection with all motions. By stipulation of the parties subject to approval or by order of the tribunal before whom the motion is pending, briefs may be received if filed otherwise than as prescribed.

(c) In oral hearings on motions, the moving parties shall have the right to make the opening and closing arguments. Unless otherwise ordered before the hearing begins, oral arguments will be limited to 30 minutes for each party.

(d) Any request for reconsideration or modification of a decision or other action by the Board of Patent Interferences or patent interference examiner, must be filed within 20 days after the date of the decision, or other action and any reply thereto must be filed within 20 days from the date of service of the

request. With regard to requests for reconsideration of a decision after final hearing, see § 1.256(b).

### § 1.245 Extension of time.

Extensions of time in any case not otherwise provided for may be had by stipulation of the parties, subject to approval, or on motion duly brought, sufficient cause being shown for such extension. A motion not timely made may be considered upon a showing of sufficient cause as to why such motion was not timely presented.

DR. ROGER VARIN'S TESTIMONY; PAGES 98, 99, 102, 110, 180, 181 SUBMITTED BY PETITIONER IN APPENDIX BEFORE CCPA; PAGE 182 SUBMITTED BY RESPONDENT KLEIN IN APPENDIX BEFORE CCPA.

[98] DR. VARIN—*Cross-Examination.*

something else, and I don't want to try and get last word in here. I would like to get on with it.

*Cross-Examination by Mr. Mason.*

Q. Dr. Varin—and now you know why attorneys argue back and forth—have you ever given testimony before in any proceeding?

A. Not in a patent proceeding.

Q. Not in an interference proceeding?

A. No.

Q. Now, let's get a start on this. As I understood it, the period of your Riegel employment was the year 1962 to 1971.

A. That's correct.

Q. And what was the date in '71 that you left Riegel?

A. It was in March, '71.

Q. March 1, you think?

A. No. I don't recall the exact date. It was sometime in March.

Q. And during the entire period of your Riegel employment, you were the Director of Research and Development; was that your title?

A. That's correct.

Q. And as I understand it broadly, from your testimony [99] yesterday, your duties in a broad sense were to initiate certain projects for Riegel. That was one thing—

A. Yes.

Q. —you mentioned, and I think you mentioned projects on products, or processes, or product improvement, right?

A. Yes.



*Varin Testimony*

Q. And that it came under your direction to assign projects to other people—

A. Yes.

Q. —generally other people who might be under you, I assume?

A. Yes.

Q. Were you in any sense over the Alto plant?

A. No.

Q. But you did have some relationship to the Alto plant, where I understand manufacturing is carried out, did you not? And you can tell me in your own words what it is.

A. Well, it was a relationship which is typical for our corporation in that in my position I had communication with practically everybody in the corporation.

Q. You were privy to interdepartmental memos that may originate in manufacturing, right?

A. Not entirely, no.

Q. But some of the documents we saw yesterday did go to

\* \* \* \* \*

[102] you?

A. Yes.

Q. And you had at least some relation to marketing, right?

A. Yes.

Q. I mean, it's a cooperative venture.

A. Right.

Q. Now, this general relationship that I'm talking about covered the entire period that you were Director of Research; am I right in that?

A. Yes.

Q. From '62 till March of 1971.

A. Yes.

(Off Record)

*Varin Testimony*

Q. I'm not intending to belabor the point, but I notice on the documents which were produced under Rule 287 for our perusal, and I'm using the document numbers as they were produced for us under Rule 287, that there were documents Three, Four, Five, Six, Seven, Eight, Nine, Ten, Eleven, Twelve, Thirteen, Sixteen, Seventeen, and Thirty-One, which either were to you, or you were copied.

Mr. Ranalli: Excuse me. I would like to object. Dr. Varin was not the party who prepared that listing, and I would like the listing at least to be shown in him so he can have some idea of what

\* \* \* \* \*

[110] were kind of a patent liason (sic) man too, weren't you?

A. I was the person responsible for the contacts with patent attorneys.

Q. So you had some liason (sic) work with patent attorneys, with marketing, with manufacturing, with R and D, isn't that—

A. Yes.

Q. And the answer to all those is "yes". And I follow it up by saying, did you have any contacts with your advertising people?

A. In a sense, yes.

Q. So there were lots of fingers radiating from Dr. Varin in his responsibilities?

A. Yes.

Q. And this is during the period 1968, 1969, 1970?

A. Yes.

Q. I wanted to come back for just a second to Ware Shoals here, and again I wondered if you had drawing equipment present around here in Ware Shoals, particularly in the years we're interested in, in 1968, 1969, and 1970?

A. Yes.



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*Varin Testimony*

Q. And where would that—can I say “draw frame”? Is that a good term to use?

A. Yes.

Q. And where was that? Was that in the mill here at Ware

\* \* \* \* \*

[180] best of your recollection?

A. The information that would naturally be passed on would be the results developed in the experiments that were run in late January.

Q. Was there a write-up of the project?

A. I don't know. I don't remember that. I cannot—

Q. Was there an exchange of correspondence which concerned the disclosure you were making?

A. There probably was.

Q. Have you seen that?

A. I have no recollection of it.

Q. Do you think you wrote a letter in respect to it, Doctor?

A. Possibly so.

Q. And that would be in the files of Riegel, though, wouldn't it?

A. Yes.

Q. And not your personal file.

A. It might be in a carbon copy.

Q. But you don't have any carbon copies of your Riegel papers at home, do you?

A. I have a set of carbon copies of the things that I wrote.

Q. Have you been asked to go through those, Doctor?

[181] A. We—I have not been asked. I went through them myself.

Q. Did you find anything relating to this proceeding?

A. There were some things.

Q. Have they been identified in evidence here, these things that you found in your personal file?

A. I don't believe so.

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*Varin Testimony*

Q. Do you still have those?

A. Yes.

Q. Did you show them to opposing counsel?

A. Yes.

Q. Would you be willing to show them to us?

A. That's not my decision. They're the property of Riegel.

Q. These copies of documents that you have written, and which you say you have in your possession, have you had them in your possession since the time you left Riegel in 1971 until today?

A. Yes. Well, until a few days ago, when I turned them over to Riegel.

Q. I see. In other words, that file that you had at home, you no longer have at home; is that right? And I'm talking about these papers that you've written—

A. Pertaining to that time we're talking about.

Q. You turned them over to Riegel.

A. Yes.

[182] Q. And they have them right now?

A. Yes.

Mr. Mason: I ask that those be produced also.

Mr. Ranalli: All the documents?

Mr. Mason: Those that relate to this subject matter, Counsel.

Mr. Ranalli: The request is refused.

Mr. Mason: Make a note of that, John. I think they're relevant, and I think we're entitled to them, and I renew my request that they be produced, because they were written by this Witness, and he has said they relate to this subject matter. I just want to put it on the record, and I'll get them when the time comes.

Q. Do you know who at Riegel authorized the filing of the patent application resulting in Goodbar et al application, serial number 63755? And I'm showing the Witness this copy of the

*Varin Testimony*

patent. That's 63755, and that's the one that's in interference, Doctor.

A. The filing of the application?

Q. Yes. I want to know who authorized the filing of it.

A. I did.

Q. Was there anyone to whom you reported at Riegel, who told you to file the application?

STIPULATION OF MARCH 23, 1979 BETWEEN  
GOODBAR ET AL AND KLEIN

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Interferences

R. C. GOODBAR ET AL

vs.

W. G. KLEIN

} Interference No.  
98,935

STIPULATION

WHEREAS the party Klein has cause to be issued a subpoena duces tecum (annexed hereto as Exhibit "A") by the United States Court for the Southern District of New York,

WHEREAS the party Goodbar et al. has indicated that it will request an Order to Show Cause to issue from said Court as to why said subpoena should not be quashed under F. R. Civ. P. Rule 45(b), it is

HEREBY STIPULATED AND AGREED by and between counsel for the respective parties that:

1. The party Goodbar et al. shall, prior to March 30, 1979, file with the CCPA a Petition For A Writ Of Mandamus seeking a reversal of the Order of the Board of Patent Interferences dated March 1, 1979 and the Commissioner of Patents and Trademarks dated January 15, 1979, ordering the party Goodbar et al. to produce certain documents and things, and will at the same time seek a stay of the Orders of both the Board of Patent Interferences and the Commissioner of Patents and Trademarks compelling such production on March 30, 1979 until a decision is made by the CCPA on the party Goodbar et al's Petition For A Writ Of Mandamus.

2. In the event the party Goodbar et al. is not successful in achieving a reversal of the Order of the Board of Interferences

Stipulation of March 23, 1979

and the Commissioner compelling the party Goodbar et al. to produce certain documents and things, the party Goodbar et al. will make available such documents and things to counsel for the party Klein for inspection and copying, at the offices of Riegel Textile Corporation in Greenville, South Carolina, upon giving reasonable notice to counsel for the party Klein, which shall not be less than seven (7) days prior to the date ultimately set for production of said documents by Order of the Board.

3. The party Klein hereby withdraws said subpoena, but reserves the right to seek a similar subpoena from any court having jurisdiction over the documents and things in issue in the event the party Goodbar et al. does not comply with an Order from the Patent and Trademark Office compelling production following a decision by the CCPA denying the party Goodbar et al's Petition For A Writ Of Mandamus.

Of Counsel

LLOYD W. MASON

Reg. No. 17,677

WEGNER, STELLMAN,

McCORD, WILES &amp; WOOD

20 North Wacker Drive

Chicago, Illinois 60606

JOHN G. HEIMOVICS

Reg. No. 25,038

Brunswick Corporation

Skokie, Illinois 60076

/s/ MARVIN N. GORDON

Marvin N. Gordon

Reg. No. 23,094

Attorney for party Klein

Hopgood, Calimafde,

Kalil, Blaustein &amp;

Lieberman

60 East 42 Street

New York, New York

10017

/s/ JOSEPH J. C. RANALLI

Joseph J. C. Ranalli

Reg. No. 29,104

Attorney for party

Goodbar et al

Subpoena Duces Tecum Served on Joseph J. C. Ranalli,  
Counsel for Goodbar et al, March 20, 1979

## EXHIBIT A.

Deposition Subpoena to Testify or Produce  
Documents or Things

UNITED STATES DISTRICT COURT

For the

Southern District of New York

GOODBAR ET AL

vs.

KLEIN

}

Patent  
Interference No.  
98,935

TO Joseph Ranalli and Reid Goodbar  
Pennie & Edmonds  
330 Madison Avenue  
New York, New York 10017

YOU ARE COMMANDED to appear at Pennie & Edmonds, 330 Madison Avenue in the city of New York on the 26th day of March, 1979, at 10:00 o'clock a.m. to testify on behalf of party Klein at the taking of a deposition in the above entitled interference pending in the United States Patent Office and bring with you<sup>1</sup>

Documents and things listed on Schedule A.

Dated March 20, 1979.

RAYMOND F. BURGHARDT,

Attorney for

Clerk.

Address

By Illegible

Deputy Clerk.

1. Strike the words "and bring with you" unless the subpoena is to require the production of documents or tangible things, in which case the documents and things should be designated in the blank space for that purpose. If testimony by an organization representative or designee is requested, describe with reasonable particularity the matters on which examination is requested.



App. 36

*Subpoena Duces Tecum Served on Joseph J. C. Ranalli,  
Counsel for Goodbar et al, March 20, 1979*

Any subpoenaed organization not a party to this suit is hereby admonished pursuant to Rule 30(b)(6), Federal Rules of Civil Procedure, to file a designation with the court specifying one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and shall set forth, for each person designated, the matters on which he will testify or produce documents or things. The persons so designated shall testify as to matters known or reasonably available to the organization.

RETURN ON SERVICE

Received this subpoena at \_\_\_\_\_ on \_\_\_\_\_  
\_\_\_\_\_ and on \_\_\_\_\_ at \_\_\_\_\_  
served it on the within named \_\_\_\_\_  
by delivering a copy to h\_\_\_\_\_ and tendering to h\_\_\_\_\_ the fee  
for one day's attendance and the mileage allowed by law.<sup>2</sup>

Dated: \_\_\_\_\_,  
\_\_\_\_\_, 19 \_\_\_\_\_

Service Fees \_\_\_\_\_ By \_\_\_\_\_

Travel \_\_\_\_\_ \$ \_\_\_\_\_

Services \_\_\_\_\_

Total \_\_\_\_\_ \$ \_\_\_\_\_

2. Fees and mileage need not be tendered to the witness upon service of a subpoena issued in behalf of the United States or an officer or agency thereof, or upon service of a subpoena issued on behalf of a party, authorized to proceed in forma pauperis, where the payment thereof is to be made by the United States marshal, as authorized in section 1825 of title 28, U. S. C.

App. 37

*Subpoena Duces Tecum Served on Joseph J. C. Ranalli,  
Counsel for Goodbar et al, March 20, 1979*

I certify under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.  
Executed on \_\_\_\_\_, 19\_\_\_\_\_

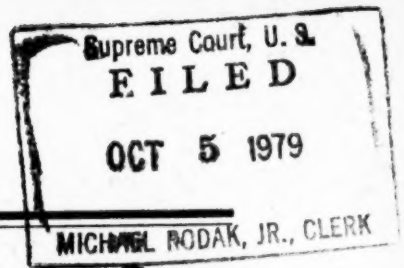
NOTE: Certification required only if service made by a person other than a United States Marshal or his deputy.

SCHEDULE A

1. All photographs taken in connection with the Goodbar et al patent application as specified in Request No. 4 of the party Klein in its Motion for Production Under C. F. R. Section 1.287(b) and (c).

2. All documents contained in Dr. Varin's file and its contents as specified in Request No. 5 of the Party Klein in its Motion for Production Under C. F. R. Section 1.287(b) and (c).

No. 79-223



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**In the Supreme Court of the United States**

OCTOBER TERM, 1979

---

REID C. GOODBAR and ARTHUR M. PRESSLEY,  
PETITIONERS

v.

DONALD W. BANNER, COMMISSIONER OF PATENTS  
AND TRADEMARKS, ET AL.

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*ON PETITION FOR A WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF  
CUSTOMS AND PATENT APPEALS*

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**MEMORANDUM FOR THE  
FEDERAL RESPONDENTS IN OPPOSITION**

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WADE H. MCCREE, JR.  
*Solicitor General*  
*Department of Justice*  
*Washington, D.C. 20530*

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*In the Supreme Court of the United States*

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*ON PETITION FOR A WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF  
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---

**MEMORANDUM FOR THE  
FEDERAL RESPONDENTS IN OPPOSITION**

---

1. This petition arises from a denial by the Court of Customs and Patent Appeals of interlocutory relief from a discovery order issued by the Patent and Trademark Office Board of Patent Interferences (the "Board") in patent interference proceeding No. 98,935. The proceeding involves a dispute between two private parties over the priority of patents covering a method of blending textile fibers and metal filaments used in the manufacture of certain yarns.<sup>1</sup> The discovery order at

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<sup>1</sup>The real parties in interest in the patent interference proceeding are the Riegel Textile Corporation, petitioners' assignee, and the Brunswick Corporation, assignee of respondent Klein (CCPA App. 65-66). ("CCPA App." refers to the Appendix to Petition for Writ of Mandamus in the Court of Customs and Patent Appeals.)



issue developed from the testimony of Dr. Roger Varin, a former employee of petitioners' assignee, that he had maintained correspondence during his employment that related to the instant proceeding (Pet. App. A2). Pursuant to discovery rules promulgated by the Patent Office, 37 C.F.R. 1.287, respondent William Klein filed a motion for production of, *inter alia*, the correspondence alluded to in the Varin testimony. Petitioners opposed the production request on grounds that it was untimely, not in the interest of justice, and unduly broad, and that the correspondence was irrelevant and confidential (CCPA App. 64).

The Board ordered disclosure of various items, including the Varin correspondence to the extent that it related to the interference proceeding (Klein Br. in Opp. App. 14-19). Petitioners appealed that part of the order addressing the Varin correspondence to the Commissioner of Patents and Trademarks, who upheld the Board's order (*id.* at 9-12). Respondent Klein thereupon secured the issuance of a subpoena *duces tecum* from the United States District Court for the Southern District of New York pursuant to 35 U.S.C. 24, directing petitioners and their counsel to produce the Varin correspondence.<sup>2</sup> Subsequently, the subpoena was withdrawn by stipulation (Klein Br. in Opp. App. 33-34).

<sup>2</sup>35 U.S.C. 24 provides in pertinent part:

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Petitioners then petitioned the Court of Customs and Patent Appeals for a writ of mandamus to vacate the discovery order. The court denied relief and dismissed the petition for lack of subject matter jurisdiction (Pet. App. A1-A8). The court observed that "[t]he All Writs Act [28 U.S.C. 1651(a)] is not an independent grant of appellate jurisdiction, and, therefore, the appellate jurisdiction which the writs are 'in aid of' must have some other basis" (Pet. App. A5). Since its appellate jurisdiction in patent interference proceedings is limited to issues involving the question of priority of patents under 35 U.S.C. 141 and matters ancillary to determinations of priority, the court concluded that the issue involved here—the scope of discovery—must fall within that ambit for mandamus to be available.

The court noted that "[a]t this stage of the proceeding, it is not known whether the requested discovery will actually lead to *legally relevant* and *admissible* evidence" (Pet. App. A7; emphasis in original). It therefore held that the discovery dispute "is certainly not a question of priority, and we are of the opinion that it is not ancillary to priority as the case law has developed the meaning of that term. The happenstance that the ordered discovery *might* result in evidence bearing upon or even establishing priority does not make this issue ancillary to priority" (*id.* at A7-A8; emphasis in original). Accordingly, the court concluded that it was without jurisdiction to entertain the mandamus petition (*id.* at A8).

2. The decision of the court below is correct and presents no issue warranting further review. The result reached by the Court of Customs and Patent Appeals is in accord with the general rule that orders granting or denying discovery are not subject to immediate appellate review. *United States v. Nixon*, 418 U.S. 683, 688-689 (1974); 4 *Moore's Federal Practice* para. 26.83[3] (2d ed.

1976). This is especially true when interlocutory review is sought by way of mandamus, which is "a drastic [remedy], to be invoked only in extraordinary situations." *Kerr v. United States District Court*, 426 U.S. 394, 402 (1976). The record is barren of any grounds for an exception to this settled rule. Although petitioners contend that issuance of a writ of mandamus is necessary "to prevent dissemination of privileged and confidential information" (Pet. 6), they have never substantiated this claim at any point in the proceedings.<sup>3</sup>

The Court of Customs and Patent Appeals properly dismissed the mandamus petition for want of jurisdiction rather than deny it on the merits. The court's narrow appellate jurisdiction in interference proceedings results in correspondingly limited jurisdiction to issue writs of mandamus. Therefore, the cases relied upon by petitioners (Pet. 7) are inapposite, since in those cases the appellate courts would have had jurisdiction over the issues involved in the mandamus proceedings had they arisen on appeal.

Petitioners allege a conflict (Pet. 8-9) between the decision of the court below and that of the Second Circuit in *Shattuck v. Hoegl*, 555 F. 2d 1118 (1977). However, the decisions can be readily harmonized. The court in *Shattuck* ruled that a party to an interference proceeding could not take an interlocutory appeal from a district court order denying discovery under 35 U.S.C. 24. The court went on to observe that its dismissal of the

<sup>3</sup>Before the Board, petitioners objected on numerous grounds to respondent Klein's general discovery request, asserting "confidential business information" but not asserting privilege (CCPA App. 64). Petitioners have not amplified these claims subsequently, and the privilege claim appears founded solely upon a passing remark in Dr. Varin's testimony that he "was the person responsible for the contacts with patent attorneys" (Klein Br. in Opp. App. 29).

appeal in the collateral discovery proceeding did not leave the appellant without a remedy, because Patent Office Rule 287, 37 C.F.R. 1.287, provides for the conduct of discovery in the main proceeding. The court then stated (555 F. 2d at 1121): "Moreover, a party disappointed by an interference proceeding has access to two Article III courts. An appeal may be taken to the Court of Customs and Patent Appeals. If that court finds that discovery against a party should have been ordered, it can vacate the decision of the Patent Office. Alternatively, the losing party may seek review in a district court, in which a trial *de novo* will be held."

Petitioners read the quoted language as a recognition by the Second Circuit that discovery matters, as distinguished from evidentiary matters, are reviewable by the Court of Customs and Patent Appeals. But there is no justification for reading the language so expansively. The *Shattuck* court, in commenting in dicta on the alternative remedies available to the appellant, had no occasion to engage in a careful examination of the jurisdiction of the Court of Customs and Patent Appeals or to take account of the limitations placed on that jurisdiction by Congress. Hence, the court of appeals' broad statement that "a party disappointed by an interference proceeding has access to two Article III courts" could not have been intended to expand the right of review in interference proceedings, which is expressly limited by statute to "the question of priority." 35 U.S.C. 141, 146. Therefore, to the extent that discovery orders lead to the introduction of relevant evidence, and the admissibility or weight of that evidence



bears on the question of priority, the view expressed in *Shattuck* is fully compatible with the holding of the court below.<sup>4</sup>

Finally, this matter is not now ripe for review. Petitioners may yet seek a protective order from the Board. If that request is denied, petitioners may withhold the correspondence in issue and appeal whatever sanctions are imposed in the event they are not awarded priority. Should the subpoena withdrawn by stipulation of the parties be reissued, petitioners may seek a protective order in the district court. 35 U.S.C. 24; Fed. R. Civ. P. 26(c). Thus, petitioners have access to a number of remedies designed to safeguard confidential information against disclosure in discovery, and they were not entitled to issuance of an extraordinary writ. See generally Note, *Discovery in Patent Interference Proceedings*, 89 Harv. L. Rev. 573 (1976).

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.  
*Solicitor General*

OCTOBER 1979

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<sup>4</sup>Similarly, to the extent that Patent Office Rule 287 suggests by negative implication that discovery orders are appealable, that is the case only when and to the extent that an order leads to the discovery of evidence (or the withholding of evidence) bearing on the question of priority.